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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,687	10/16/2001	Craig R. White	10011785-1	3774

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EXAMINER
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ALI, HATEM M

ART UNIT	PAPER NUMBER
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3692

NOTIFICATION DATE	DELIVERY MODE
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02/04/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/977,687	<b>Applicant(s)</b> WHITE, CRAIG R.	
	<b>Examiner</b> HATEM ALI	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. The following is an **Office Action** in response to the communication received on **11/13/08**.

2. **Claim** status:

- **Claims** are pending: **1-8** and **21-26**

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-8** and **21-26** are rejected under 35 U.S.C. § 112, **second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, **claim 1** recites in the preamble “an electronic transaction recording system for accumulating data from a printer device has an owner and a user”, the body of the claim does not contain any limitations indicating the structure of the device. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant’s claimed limitations consist of billing manager (software according to the specification) that do not describe the structure of the device. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of **35 U.S.C. 103(a)** which forms the basis for all obviousness rejections set forth in this Office action:

**(a)** A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-8, and 21-26** are rejected under 35 U.S.C. 103 (a) as being unpatentable over ***Yamaguchi*** (6,385,675) in views of ***Okuda*** et al (7,034,952).

**As per claims 1 and 4, *Yamaguchi*** discloses an electronic transaction recording system for accumulating data from a printer (a digital copying machine **100**), having an owner and a user the system comprising:

A printing manger (**col.2** ; via account processor **101H** and accounting program and operations for costing and implied and inherent billing system), which manages printing policies for the printer device to determine a cost of each operation performed on the printer device (**col.2**, lines 60-62; via accounting program inherently processing cost of each operation);

a printing system (**col.2**, line 60+; via account processor **101 H** for processing the cost of the job based on the accounting program and a controller controlling **101 I** the accounting operations ... changing of the accounting programs), which accumulates information on usage of the printer device by the

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user, generates an accounting of usage based on the accumulated information and associates the accounting of usage with a predetermined unit of usage (**col.2**, lines 62-67 and **col.3**, lines 1-3); and

at least one database, which stores account information of the user of the printer device in terms of the predetermined unit of usage (**col.** lines 40-51; via image processor **101** stores **PDL** data into user's assigned memory with the host computer **102**);

wherein the billing system periodically updates the account information of the user of the printer device and issues an accounting of costs to the user (**col. 2**, lines 27-35 and **col.3**, lines 4-8 ; via the account notice ... to appropriate each host computer **102** ... as requested by the user [implied any users including owner).

**Yamaguchi** fails explicitly to disclose that the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user

However, **Okuda** being in the same field of invention discloses that the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user (**Fig.15-20** and **col.8-9**; via **print service shop** with ID "0001" [printer owner as building or department, refers applicant's spec. Page 9, para 2] is credited [implied with royalty of 4.5% {line 20} from the predetermined reference table record managed and updated by information unit **458** and also **col.7-8**; via server **100** with user charge management and records].

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the features mentioned by **Yamaguchi** to include the disclosures as taught by **Okuda** to facilitate the royalty payment to the print service shop per pre-set reference table data and user's use records.

**As per claims 2, Yamaguchi** discloses that the predetermined unit of usage is a token (**col.1**, lines 35-55, via page unit as token and plurality of operational mode as event and based on command from the host computer make the total charge for the printing to the host computer through a circuit **100F** for managing and logging each job as an account).

**As per claim 3, Yamaguchi** discloses that the printing system further accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device (**col.5**, lines 10-17; via the host computer **102** uses the **program software** to carry out the **specified functions** [operator can **change the functions** if desired] for **billing the owner** as estimated for the net usage).

**As per claims 5 and 6, Yamaguchi** discloses all the elements of the claimed invention, but fails to explicitly disclose a mobile access unit coupled to the billing manager, wherein the mobile access unit indicates content to be printed at the printer\_device and selected from the group consisting of a personal digital assistant, a wireless telephone and a mobile computer.

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However, **Okuda** being in the same field of invention discloses a mobile access unit coupled to the billing manager, wherein the mobile access unit indicates content to be printed at the printer device and selected from the group consisting of a personal digital assistant, a wireless telephone and a mobile computer (**Figs.2-3** and **col.3**, lines 4-9 and 27-51; via mobile telephone or portable PC are used as the user terminal **102** to a system of the print service shop **101**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the disclosure and features mentioned by **Yamaguchi** and to include the teachings of **Okuda** to facilitate in order to handle a print request from the mobile user terminals connected through the Internet having web browser facilities.

**As per claim 7, Yamaguchi** discloses that a configuration unit coupled to the billing policy database for updating and configuring billing policies for new users of the printer device (**col.2**, lines 65-67; via the host computers-**102** may be new users to be configured by the controller **101 I**).

**As per claims 8 and 26, Yamaguchi** teaches all elements of the claimed invention, but fails to explicitly disclose the printing system is selected from a back office printing system and Internet Settlement Model.

However, **Okuda** being in the same field of invention discloses the printing system is selected from a back office printing system and Internet Settlement Model (**col.4**, lines 35-47; via the fee computer **408**, the settlement maker **409**

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and settlement information unit **457** with print service server **100**, inherently charges printing fees and does the back office billing system online [**Internet**]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the disclosure and features as mentioned by *Yamaguchi* to include the teachings of *Okuda* to facilitate a fee collector (**508**) to collect charge amount by means of prepaid card or the like

**As per claims 21, 22, 23 and 24, Yamaguchi** discloses the system comprising a plurality of printer devices connected over a network (**col. 2**, lines 15-30),

the printing manager (**Fig.2, col.2**; line 63; via controller **101 I** for controlling the account operation) is coupled to each printer device for determining the amount of printer usage and associating a predetermined amount of token values with the amount of printer usage (**col.2**, lines 62-67 and **col. 3**, lines 1-3); and

a printing policies database, which includes billing policies for the printer devices such that the each printer device uses at least one billing policy to determine a cost of each operation, performed on the printer (**col.2**, lines 27-35 and **col.3**, lines 4-8 and inherent programmed function for cost of each operation).

*Yamaguchi* fails to explicitly disclose that a mobile access unit containing content which is to be printed and each printer device can receive the content from the mobile access unit and print the content in responses to an authorization process.



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However, **Okuda** being in the same field of invention discloses that a mobile access unit containing content which is to be printed and each printer device can receive the content from the mobile access unit and print the content in responses to an authorization process (**col.3; Fig.2**; via mobile telephone as user terminal **102** has a function of a data terminal, internet, gateway server and user verification [implied relation to acceptance] and the like ; **col.4**; lines 11-16; via the job collector **403** accept job data mainly print request from a user)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the disclosure and features mentioned by **Yamaguchi** to include the teachings of **Okuda** to facilitate the acceptance of verified print request from online users for printing services.

As per claim 25, **Yamaguchi** discloses that a user configuration unit coupled to the printing policies database for updating and configuring printing policies for new users of the printer devices (**col.2**, lines 65-67; via the controller **101** I control the copying machine **100** to carry out a function specified by host computers **102** inherently payment policies related to new users).

### ***Response to Arguments***

7. **Applicant's** arguments, filed **11/13/08**, with respect to **Asawaka** reference as common ownership have been fully considered and are persuasive. As such the **Asawaka** reference has been withdrawn.

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However, it is to be **noted** that per MPEP, the entire prior Art is applicable and Applicant should look at the entire Prior Art. (Ref. **Okuda** in place of Asawaka)

**Applicant** argued (remark page 6, line 22) that “More importantly, the **Yamaguchi** reference does not even mention the owner of the printer or copying machine.” In response to applicant's arguments, The **Examiner** respectfully refers the recitation (**claim 1**, line 2) “a printer device having an owner and a user” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). *Moreover, it is clear with Okuda (Fig.1* via Print service shop **101** and user terminal **102**)

**Applicant** further argued (remark page 7, lines 6+) that Yamaguchi reference does **not** disclose a billing system ... wherein the billing system credits the owner of the printer device ... by the user as claimed in independent claim 1. The **Examiner** respectfully further refers **Okuda (Fig.15-20** and **col.8-9**; via print service shop with ID “0001” [printer owner as building or department] is credited [implied with royalty] with royalty of 4.5% [line 20] from the predetermined reference table record managed and updated by information unit **458** and also **col.7-8**; via server **100** with user charge management and records).

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HATEM ALI whose telephone number is (571)270-3021. The examiner can normally be reached on 8.00 to 6.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/  
Primary Examiner, Art Unit 3692

Hatem Ali  
Examiner  
Art Unit 3692

